

Application No.: 10/815,149  
Amdt dated: August 6, 2009  
Reply to Office action of May 7, 2009

### **REMARKS/ARGUMENTS**

This paper is filed in response to the Office Action dated May 7, 2009. Claims 10-18 and 24-28 were considered by the Examiner. In this paper, Claim 10 has been amended, no claims have been canceled, and no new claims have been added. Accordingly, Claims 10-18 and 24-28 remain pending for consideration. No new matter has been added in these amendments.

#### **Summary of the Office Action**

In the Office Action, Claims 10-18, 24-26, and 28 were rejected under 35 U.S.C. § 102(a) as being anticipated by Yawata et al. (PCT Application Publication No. WO 2004/008944 A2). Claims 10-18, 27, and 28 were rejected under 35 U.S.C. § 102(b) as being anticipated by Burbank et al. (US Patent No. 5,431,668). For at least the following reasons, Applicant respectfully traverses these rejections.

#### **Request for Clarification of Inconsistency in Office Action**

Upon review of the Office Action, Applicant notes that on the sheet entitled Office Action Summary, in line item 4a, it is indicated that Claims 24-28 are withdrawn from consideration. However, Claims 24-28 appear to have been considered in line item 6 of the Office Action Summary, and items 3 and 4 of the Detailed Action. Accordingly, the indication that that these claims have been withdrawn appears to be a

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minor inconsistency. Thus, Applicant is proceeding assuming that Claims 24-28 remain pending and will continue to be considered by the Examiner. Applicant respectfully requests clarification should the Examiner believe these claims to have been withdrawn.

### **Yawata Does Not Disclose the Recited Single Clip Jaw Assembly**

Claim 10 relates to a single clip jaw assembly comprising, among other limitations, a pair of jaws and a housing. The housing has "no clip loading mechanism housed therein." The jaw assembly is configured to receive "*only a single surgical clip at a time*," and the pair of jaws is adapted to receive a surgical clip "*exteriorly* of the jaw assembly." (Emphasis added).

Unlike the jaw assembly recited in Claim 10, Yawata describes a disposable cartridge in which a "*series of clips* 108 can be stacked end-to-end in a clip channel 104." (Yawata, page 9, lines 5-6, Fig. 10, emphasis added). Yawata further describes a mechanism, located within a top housing 102 and a bottom housing 101, to feed the clips and to assure complete closing of each clip of these series of clips. (Yawata, page 9, line 13-page 11, line 10, Figure 10). Thus, unlike the jaw assembly recited in Claim 10, a clip loading mechanism is contained within the housing.

Accordingly, for at least the reasons discussed above, Claim 10 is distinguishable over Yawata. Claims 11-18, 24-26, and 28 depend from Claim 10 and recite additional novel and nonobvious limitations thereon. Accordingly, Claims 11-18,

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24-26, and 28 are likewise distinguishable over Yawata for at least the reasons discussed above with respect to Claim 10.

### **Burbank Does Not Disclose a Single Clip Jaw Assembly**

Burbank relates to a "multiple clip applier" (Burbank, col. 5, lines 18-19). The Burbank device includes mechanisms, including feed bar 106 and clip closing channel 54 within the shaft 16 to perform the clip closing and feeding functions. (Burbank, col. 9, lines 1-42, Figures 8, 10). Thus, the Burbank device includes a clip loading mechanism disposed within the shaft, unlike the jaw assembly recited in Claim 10, which recites no clip loading mechanism is housed within the housing.

Burbank discloses multiple clips being stored in a magazine. (See, e.g., Burbank, col. 9, lines 43-46, Figs.1-3). These clips are automatically fed such that the jaws are never empty. (Burbank, col. 8, lines 13-15). Burbank further indicates that multiple lockout mechanisms prevent the device from being used when no clips are present in the magazine. (Burbank, col. 9, lines 43- col. 10, line 31). Thus, the Burbank device is incapable of use to apply a single surgical clip at a time. Burbank fails to disclose a jaw assembly configured to receive "only a single surgical clip at a time," as is recited in Claim 10. Further, Burbank fails to disclose a pair of jaws configured to receive a clip "exteriorly" of the jaw assembly, as is recited in Claim 10.

Accordingly, for at least the reasons discussed above, Claim 10 is distinguishable over Burbank. Claims 11-18, 27, and 28 depend from Claim 10 and recite additional novel and nonobvious limitations thereon. Accordingly, Claims 11-18,

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27, and 28 are distinguishable over Burbank for at least the reasons discussed above with respect to Claim 10.

### **Conclusion**

For at least the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowability is most earnestly solicited.

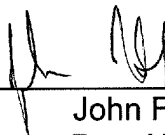
Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

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The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, John F. Heal, at (949) 713-8283 to resolve such issues promptly.

Sincerely

APPLIED MEDICAL RESOURCES

BY  \_\_\_\_\_  
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